

Appln. No. 10/671,347
Docket No. 132104 / GEN-0379

REMARKS / ARGUMENTS

Status of Claims

Claims 1-11 are pending in the application. Claims 1-4 and 9-11 are allowed. Claim 5 is rejected. Claims 6-8 are objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims. Of the pending claims, Applicant herein provides clarifying remarks, for consideration by the Examiner, to traverse the rejections. No claim amendments have been made, and therefore under 37 CFR 1.121, no claim listing is provided herewith.

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Raso et al. (U.S. Patent No. 4,939,492, hereinafter Raso) in view of MacLean (U.S. Patent No. 4,399,421, hereinafter MacLean).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

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The Examiner acknowledges that Raso does not disclose a means for adjusting the air gap in the absence of adjustment to the trip force, and looks to MacLean to cure this deficiency. Paper 122004, page 2.

Applicant respectfully disagrees.

In looking to MacLean, the Examiner alleges that MacLean discloses an adjustable trip coil having means [72] for adjusting the air gap between a movable plunger [38] and fixed core [61] *and not adjusting the trip force*. Paper 122004, page 2 (emphasis added).

In contradiction to the Examiner's allegation, Applicant submits that MacLean discloses a slot 72, a screw 70, and a mating cup 50, for moving the plunger 38 in the direction of arrow 39, which also results in movement of the return spring 54. Column 4 lines 8-12 and lines 58-61. Applicant further submits that MacLean discloses a relationship between the air gap and trip force such that *while the magnetic force greatly increases* in non-linear fashion, *the opposing spring force increase* is essentially linear during the stroke. Column 5 lines 26-29 (emphasis added).

In Figure 5 of MacLean, Applicant finds MacLean to disclose a trip force that changes from about 1.1 pounds at zero stroke to about 0.5 pounds at 5/8 inch stroke. In view of the teaching of MacLean, Applicant submits that an adjustment of screw 70 not only moves the plunger 38 to adjust the air gap, but also compresses the return spring 54 thereby changing the trip force.

In view of the foregoing, Applicant submits that MacLean discloses a means for adjusting the air gap *in the presence of* adjustment to the trip force, and therefore necessarily cannot also disclose a means for adjusting the air gap *in the absence of* adjustment to the trip force.

If Applicant were to combine MacLean with Raso as suggested by the Examiner, one skilled in the art would still be left with a means for adjusting the air gap *in the presence of* adjustment to the trip force, which is contrary to the claimed invention.

Dependent claims inherit all of the limitations of the parent claim.

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In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection, which Applicant considers to be traversed.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP

Applicant's Attorneys

By: 

David Arnold
Registration No: 48,894
Customer No. 23413

Address: 55 Griffin Road South, Bloomfield, Connecticut 06002
Telephone: (860) 286-2929
Fax: (860) 286-0115